



IFW

PTO/SB/21 (02-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/786,763	
	Filing Date	February 24, 2004	
	First Named Inventor	Eduard K. de Jong	
	Art Unit	Unassigned	
	Examiner Name	Unassigned	
Total Number of Pages in This Submission		Attorney Docket Number	SUN-P9176

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): 1449 citing 43 pieces of art
<div>Remarks</div>		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual name	John P. Schaub, Reg. No. 42,125	
Signature		
Date	May 26, 2004	

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name	Diane Palmer		
Signature		Date	May 26, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Docket No. SUN-P9176
(811173-000507)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Eduard K. de Jong
SERIAL NO.: 10/786,763
FILING DATE: February 24, 2004
TITLE: Method and Apparatus for Providing an Application on a Smart Card
EXAMINER: Unassigned
ART UNIT: Unassigned

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as First Class
Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450,
on the date printed below:

Date: 5-26-04

Name: *Diane Palmer*
Diane Palmer

COMMISSIONER FOR PATENTS
P.O. Box 1450, ALEXANDRIA, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Each item of information listed in the attached FORM PTO-1449, for which a copy of each is attached (unless the blanket waiver referred to below applies), may be material to the examination of the above-identified application and is, therefore, submitted in compliance with the duty of disclosure defined in 37 CFR §§ 1.56, 1.97 and 1.98. The Examiner is requested to review, consider and document each such item in the official record of this application.

Note: If this box ☒ is checked, this case was filed after June 30, 2003 and qualifies for the blanket waiver of deposit of copies of U.S. Patents and U.S. Patent Application

Publications in accordance with the written waiver of 37 CFR §1.98 (a)(2)(i) dated July 11, 2003. Accordingly, such copies are not attached.

This Information Disclosure Statement under 37 CFR §§ 1.56, 1.97 and 1.98 is not to be construed as a representation that a search has been made, that additional information material to the examination of this application does not exist, or that any one or more of these items constitutes prior art.

I

This statement is filed pursuant to:



37 C.F.R. § 1.97(b).

This information disclosure statement is filed either:

- (1) within three months of the filing date of a national application other than a continued prosecution application under §1.53(d);
- (2) within three months of the date of entry of the national stage as set forth in 37 C.F.R. §1.491 in an international application;
- (3) before the mailing date of a first office action on the merits; or
- (4) before the mailing of a first office action after the filing of a Request for Continued Examination under 37 C.F.R. §1.114, **whichever event occurs last.**

Accordingly, this information disclosure statement requires no fee and no certification.



37 C.F.R. § 1.97(c).

This information disclosure statement is filed **after** the period specified in 37 C.F.R. § 1.97(b), but **before** the mailing date of any of the following:

- (1) a final action under 37 C.F.R. § 1.113;
- (2) a notice of allowance under 37 C.F.R. § 1.311; or
- (3) an action that otherwise closes prosecution in the application.

Accordingly, this information disclosure statement requires either:

- (1) the fee specified in 37 C.F.R. § 1.17(p) for submission of an information disclosure statement under 37 C.F.R. § 1.97(c); or
- (2) a certification according to 37 C.F.R. § 1.97 (e)(1) or (2).



37 C.F.R. § 1.97(d).

This information disclosure statement is filed **after** the period specified in 37 C.F.R. § 1.97 (c).

Accordingly, this information disclosure statement requires:

- (1) a certification in accordance with 37 C.F.R. § 1.97(e); and
- (2) the fee specified in 37 C.F.R. § 1.17 (p) to consider an information disclosure statement under 37 C.F.R. § 1.97(d).

If this statement crosses in the mail with an office action, or is otherwise not in the indicated category of 37 C.F.R. § 1.97, it is respectfully requested that this statement be treated in the next appropriate category and made of record. **To the extent required, please treat this paper as a conditional petition for acceptance of the information disclosure statement.**

II

Fees Due:

☒

No fee is due.

☐

The fee specified in 37 C.F.R. § 1.17(p) for submission of an information disclosure statement under 37 C.F.R. § 1.97(c) or 37 C.F.R. § 1.97(d) is enclosed (\$180).

III

Certification:

☒

No certification is necessary.

☐

Pursuant to 37 C.F.R. § 1.97(e)(1), the undersigned hereby certifies:

That each item of information contained in this information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement.

☐

Pursuant to 37 C.F.R. § 1.97(e)(2), the undersigned hereby certifies:

No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this information disclosure statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this information disclosure statement.


IV

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Please charge any additional required fee or credit any overpayment to our deposit account number 50-1698.

Respectfully submitted,
THELEN REID & PRIEST LLP

Dated: 5/26/04



John P. Schaub
42,125

THELEN REID & PRIEST LLP
P.O. Box 640640
San Jose, CA 95164-0640
(408) 292-5800 direct dial
(408) 287-8040 direct fax

**SUN 1449 US**

Form TO 1449 (Rev. 2-32)				U.S. Department of Commerce Patent and Trademark Office		Atty. Docket No. SUN-P9176		Serial No. 10/786,763	
Information Disclosure Statement by Applicant						Applicant: Eduard K. de Jong			
(Use several sheets if necessary)						Filed: 02/24/04		Group: Unassigned	
U.S. Patent Documents									
Init.		Document No.	Date	Name	Class	Subclass	Filing Date		
	A	5,481,715	1/2/96	Hamilton, et al.	395	700	12/15/93		
	B	5,721,781	2/24/98	Deo; Vinay et al.	705	67	9/13/95		
	C	5,742,756	4/21/98	Dillaway et al.	713	200	2/12/96		
	D	5,802,519	9/1/98	De Jong et al.	707	100	7/19/96		
	E	5,844,218	12/1/98	Kawan et al.	235	380	7/16/96		
	F	5,894,550	4/13/99	Thiriet et al.	714	54	1/16/97		
	G	5,912,453	6/15/99	Gungl et al.	235	492	9/25/96		
	H	6,005,942	12/21/99	Chan et al.	713	187	3/24/98		
	I	6,038,551	3/14/00	Barlow et al.	705	41	3/11/96		
	J	6,052,690	4/18/00	Waldin, Jr. et al.	717	170	3/25/98		
	K	6,094,656	7/25/00	Jang et al.	707	100	4/8/98		
	L	6,233,683	5/15/01	Chan et al.	713	172	3/24/98		
	M	6,308,317	10/23/01	Wilkinson et al.	717	139	10/24/97		
	N	6,418,554	7/9/02	Delo et al.	717	174	9/21/98		
	O	6,477,702	11/5/02	Yellin et al.	717	126	11/9/00		
	P	6,481,632	11/19/02	Wentker et al.	235	492	10/26/99		
	Q	US/2001/0000814	3/3/01	Montgomery et al.	710	10	11/30/00		
	R	US/2002/0040936	4/11/02	Wentker et al.	235	492	10/26/99		
Examiner					Date Considered				
Examiner: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include a copy of this form with the next communication to applicant.									

SUN 1449 FOREIGN

Form PTO 1449 (Rev. 2-32) U.S. Department of Commerce Patent and Trademark Office					Atty. Docket No. SUN-P9176		Serial No. 10/786,763	
Information Disclosure Statement by Applicant					Applicant: : Eduard K. de Jong			
(Use several sheets if necessary)					Filed: 02/24/04		Group: Unassigned	
Foreign Documents								
								Translation
Init.		Document No.	Date	Country	Class	Subclass	Yes	No
	S	0748135	12/96	EP				X
	T	0865217	9/98	EP				X
	U	WO 94/30023	12/94	PCT				X
	V	WO 98/19237	5/98	PCT				X
	W	WO 98/37526	8/98	PCT				X
	X	WO 99/16030	4/99	PCT				X
	Y	WO 00/45262	8/00	PCT				X
Examiner					Date Considered			
Examiner: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include a copy of this form with the next communication to applicant.								

SUN 1449 OTHER DOCUMENTS

Form PTO 1449 (Rev. 2-32)		U.S. Department of Commerce Patent and Trademark Office	Atty. Docket No. SUN-P9176	Serial No. 10/786,763
Information Disclosure Statement by Applicant			Applicant: Eduard K. de Jong	
(Use several sheets if necessary)			Filed: 02/24/04	Group: Unassigned
Other Documents (Including Author, Title, Date, Pertinent Pages, etc.)				
	Z	Bernadat, et al., "Java Sandboxes meet Service Guarantees: Secure Partitioning of CPU and Memory", Dec. 14, 1998, The Open Group Research Institute, Cambridge, MA, pp. 1-24.		
	A1	Chan, "Infrastructure of Multi-Application Smart Card", http://home.hkstar.com/~alanchan/papers/multiApplicationSmartCard/ , July 25, 2002		
	B1	Chen, Zhiquan, "Java Card™ Technology for Smart Cards", <i>Sun Microsystems</i> , pages 11-16, June, 2000		
	C1	Dreifus, H. "Smart Cards; A guide to Building and Managing Smart Card Applications; Copyright 1998; Publisher Robert Ipsen; "Smart Card Development Skills, Methods, and Tools"; pp 159-225		
	D1	Gong, et al. "Going Beyond the Sandbox: An Overview of the New Security Architecture in the Java TM Development Kit 1.2", USENIX Symposium on Internet Technologies and Systems – December 8-11 1997, pp. 103-112.		
	E1	Hawblitzel, et al., "Implementing Multiple Protection Domains in Java", Technical Report 97-1660, Department of Computer Science, Cornell University.		
	F1	Heiss, J. et al. "Java Card™ Technology Grows Up Smart", printed on 4/22/00 at http://java.sun.com/features/1999/01/javacard.html , 5 pages.		
	G1	Thomas, David J., "Smart and Smarter: The Emergence of Java Card™ Technology", printed on 4/22/00 from http://java.sun.com/features/1998/04/javacard.html , 8 pages.		
	H1	Sun Microsystems, Inc., "How to write a Java Card applet: A developer's guide", printed on 4/22/00 from http://www.javaworld.com/javaworld/jw-07-1999/f_jw-07-javacard_p.html , 15 pages.		
	I1	Sun Microsystems, Inc. "Smart Cards: A primer", printed on 4/22/00 from http://www.javaworld.com/javaworld/jw-12-1997/f_jw-12-javadev_p.html , 13 pages.		
	J1	Sun Microsystems, Inc., "Sun's Java Card™ Technology Extends its Industry Leadership", printed 4/22/00 from http://java.sun.com/pr/1999/11/pr991116-01.htm , 5 pages.		
	K1	Sun Microsystems, Inc., "Understanding Java Card 2.0", printed on 4/22/00 from http://www.javaworld.com/javaworld/jw-03-1998/f_jw-03-javadev_p.html , 12 pages.		
	L1	Sun Microsystems, Inc., "Java Card™ Applet Developer's Guide", August 19, 1998, Revision 1.12.		
	M1	Sun Microsystems, Inc., Java Card™ 2.0 Application Programming Interfaces, October 13, 1997, Revision 1.0 Final.		
Examiner			Date Considered	
Examiner: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include a copy of this form with the next communication to applicant.				

SUN 1449 OTHER DOCUMENTS

Form PTO 1449 (Rev. 2-32)		U.S. Department of Commerce Patent and Trademark Office	Atty. Docket No. SUN-P9176	Serial No. 10/786,763
Information Disclosure Statement by Applicant			Applicant: Eduard K. de Jong	
(Use several sheets if necessary)			Filed: 02/24/04	Group: Unassigned
Other Documents (Including Author, Title, Date, Pertinent Pages, etc.)				
	N1	Sun Microsystems, Inc., "Java Card™ 2.0 Programming Concepts", October 15, 1997, Revision 1.0 Final.		
	O1	Sun Microsystems, Inc., "Java Card™ 2.1 Application Programming Interface", June 7, 1999, Final Revision 1.1.		
	P1	"Sun Microsystems Announces JAVACARD API", Business Wire, October 1996		
	Q1	Sun Microsystems, Inc., "Java Card 2.2 Application Programming Interface, Revision 1.1 for the 2.2_01 Release		
Examiner			Date Considered	
Examiner: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include a copy of this form with the next communication to applicant.				